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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/815,825	03/22/2001	Keith D. Allen	R-849	6413

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EXAMINER

PAPPU, SITA S

ART UNIT PAPER NUMBER

1632

DATE MAILED: 12/28/2001

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/815,825

Applicant(s)

ALLEN ET AL.

Examiner

Sita S Pappu

Art Unit

1632

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-48 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-48 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claims 1-48 are pending in the instant application.

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-4, drawn to a targeting construct, and a method of producing a targeting construct, classified in class 536 subclass 23.1.
- II. Claims 5-7, drawn to an embryonic stem cell, classified in class 424, subclass 93.7.
- III. Claims 8-11, 12, 17-26, 28-36, 42-47, drawn to a non-human transgenic animal, a transgenic mouse with an eye abnormality and a method of identifying an agent that ameliorates an eye abnormality, a transgenic mouse with hyperactive behavior and a method of identifying an agent that modulates hyperactive behavior, and methods of producing the transgenic mouse, classified in class 800, subclass 3.
- IV. Claims 13-15, 27, 37-40, drawn to a method of identifying an agent that modulates the expression of cGMP phosphodiesterase gene using a transgenic animal cell comprising a disruption in a cGMP phosphodiesterase gene, and wherein the phenotype associated with the gene is an eye abnormality classified in class 424, subclass 9.1.
- V. Claims 16, 41 drawn to an agent that modulates eye abnormality of a transgenic mouse, classified in class 530, subclass 300+.

VI. Claim 48 drawn to an agent that modulates hyperactive behavior of a transgenic mouse, classified in class 530, subclass 300+.

The inventions are distinct, each from the other because of the following reasons:

Invention II is drawn to an animal embryonic stem cell and/or murine embryonic stem cell, and involves methods that are materially different from Invention I and is thus, distinct from group I. The methods of producing Invention I are different from the methods of Invention II.

Invention III is drawn to a nonhuman transgenic animal and/or a transgenic mouse with an eye abnormality and/or hyperactive behaviour and a method of identifying an agent that ameliorates an eye abnormality or hyperactive behavior using the transgenic animal, and, thus, involves methods that are distinct from those of Inventions I-II.

Invention IV is drawn to a method of identifying an agent that modulates an eye abnormality, and, thus, involves methods that are distinct from those of Inventions I-II. Further, Invention IV is directed to in vivo methods of use and is, therefore, distinct from the methods of using the transgenic animal and/or the transgenic mouse of Invention III.

Inventions V and VI are directed to product-by-process claims and are distinct from the other groups. Further, the agents of Inventions V and VI modulate different phenotypes and/or abnormalities and are thus, distinct from each other.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, and

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because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sita S Pappu whose telephone number is (703) 305-5039. The examiner can normally be reached on Mon-Fri (9:00 AM - 5:00 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Deborah Crouch can be reached on (703) 308-1126. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 746 7442 for regular communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the group patent analyst, whose telephone number is (703) 305-2758.

S. Pappu
December 21, 2001

Anne-Marie Baker
ANNE-MARIE BAKER
PATENT EXAMINER